

REMARKS

This Amendment and the following remarks are intended to fully respond to the Final Office Action mailed March 15, 2006. Claims 1-28 were examined in that Office Action, and all claims were rejected. More specifically, claims 1, 2, 4-6, 8, 13, 14, 16, and 21-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Brown et al. (USPN 6,067,551); claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Pham et al. (USPN 6,560,719); claims 1, 3, 5, 9, 10, 13, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al. (USPN 5,890,177); and claims 11, 12, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al. in view of Thorne et al. (USPN 5,958,005). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Amendment, claims 1, 5, 13 and 21 have been amended. Claim 15 has been canceled, and no new claims have been added. Therefore, claims 1-14 and 16-28 remain pending for examination.

Interview Summary

The undersigned would like to thank Examiner Rachna Singh for the telephone interview conducted on June 26, 2006. The undersigned and Examiner Singh discussed possible claim amendments to the independent claims. Some of the amendments discussed included: adding language similar to claims 7 and 15, and adding language indicating that a user is prompted to make a selection that may include storing a local copy with a path to the original document. Although no agreement was reached, the Examiner indicated that such amendments may distinguish the invention over the cited art, and in particular the Brown reference.

The foregoing amendments and the following remarks are being made based on the discussion with Examiner Singh. The undersigned believes that the present amendment places the claims in condition for allowance, and respectfully requests the issuance of a Notice of Allowance.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 4-6, 8, 13, 14, 16, and 21-28 stand rejected under 35 U.S.C. § 102 as being anticipated by Brown et al. (USPN 6,067,551) “hereinafter Brown.” Applicants respectfully

submit that the amendments to the independent claims further distinguish the claims from the disclosure of Brown.

Claim 1 has been amended to recite, prompting a user to decide whether to save the local copy with the path of the original document for later merging the edits, or save the local copy without the path to the original document. Applicants respectfully submit that neither Brown nor any of the other references cited by the Examiner disclose such a limitation. Specifically, the newly amended claims require that when a determination is made that an original document is still being used by another user, the first user is given a choice of whether to create a local copy without effecting the original document, or to save the local copy with a path to the original document for later merging changes with the original document. None of the references cited by the Examiner teach or suggest such limitations.

Indeed, as previously described, the save process disclosed by Brown has two possible operations: 1) if the MCF is currently locked for changes by another user, a dialog box is displayed to a user to prompt the user to retry the saving request; and 2) if the MCF is not locked, then the MCF applies the user's edits to the master copy. See Brown, col. 12, lines 25-51. However, neither of these operations is the same as giving the user an option of whether to create a purely local copy without regard to the original document, or saving the local copy with a path to the original document for later merging changes into the original document. Thus, Brown does not anticipate newly amended claim 1.

Claim 5 has been amended to clarify that the monitoring of the original document occurs by periodically determining whether the original document is still in use by another user. Further, claim 5 has also been amended to require that the user be prompted to decide whether to merge changes made to the local copy into the original document. Applicants believe that these amendments make claim 5 further distinct from the disclosures of Brown.

Brown does not disclose any monitoring process that periodically determines whether the master copy is still in use by another user. Brown only discloses making determinations as to whether a document is still in use, when a user performs an action such as opening a file, closing a file or saving edits to a local copy of a file. See Brown, col. 11, lines 25-40; col. 12, lines 25-35 and col. 13, lines 3-19. None of these disclosures teach or suggest actively monitoring an original document to determine whether it is still in use, such as for example using a background

process (see Detailed Description page 14, lines 27-31). For at least this reason, claim 5 is distinct from Brown.

Moreover, with respect to newly amended claim 5, Brown does not disclose that in response to a monitoring step (if a determination is made that the original document is no longer in use) prompting the user to decide whether to merge changes with an original document. Indeed, Brown actually discloses the contrary, namely prompting a user to save edits when the master copy *is still in use*. See Brown, col. 12, lines 25-35. Additionally, as described above, Brown does not disclose periodically monitoring the original document, much less prompting the user in response to the monitoring to decide whether to merge changes into the original document.

Finally, claims 13 and 21 have been amended to recite language similar to claims 7 and 15. Claims 13 and 21 have been amended to recite that the path of the original document is stored as a registry key associated with the local copy. As conceded by the Examiner, Brown does not disclose this limitation. See Final Office Action (3/15/06), page 11, paragraph 6. (Below Applicants address the obviousness of claims 13 and 21 in view of Pham).

For at least these reasons, Applicants respectfully request reconsideration of the rejections to claims 1, 5, 13, and 21 in view of Brown as each of these newly amended claims are distinguishable over Brown.

Claims 2-4, 6-12, 14, 16-20, and 22-28 are also patentable over Brown as these claims depend upon one of claims 1, 5, 13, and 21, and thus recite elements that further distinguish the claimed invention from Brown.

Claim Rejections – 35 U.S.C. § 103

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in combination with Pham et al. (USPN 6,560,719) “hereinafter Pham.” Claims 1, 3, 5, 9, 10, 13, and 17-18 stand rejected under 35 U.S.C. § 103(a) over Moody et al. (USPN 5,890,177) “hereinafter Moody.” Claims 11, 12, 19 and 20 stand rejected under 35 U.S.C. § 103(a) over Thome et al. (USPN 5,958,005) “hereinafter Thome.” Applicants respectfully traverse these rejections.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Manual of Patent Examining Procedure § 2143.

As described above, claims 1 and 5 have been amended to add additional limitations that further distinguish the claimed inventions from the Brown reference. Applicants kindly submit that Pham, Moody, and Thome, alone or in any combination, fail to make up for the deficiencies in Brown. Accordingly, because the Examiner has failed to cite references that teach all of the limitations of the claims, a *prima facie* case of obviousness has not been established for claims 1 and 5.

Claims 13 and 21 are distinct from Brown because they recite storing a path to the original document as a registry key. Moody and Thome fail to make up for the deficiencies in Brown. However, the Examiner asserts that Pham renders obvious the limitation of storing a path to the original document as a registry key associated with a local copy (see rejection of claims 7 and 15). Applicants kindly submit that the Examiner has not provided the requisite motivation to modify the Brown reference (or any other reference) with Pham to create the invention claimed in newly amended claims 13 and 21.

The Examiner’s stated motivation for someone of ordinary skill in the art to combine the Pham reference with Brown is:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate registry key association with a local copy in the system of Brown because it keeps the user from having to provide a manual backing-up of the registry keys everytime [sic] something is updated.

Final Office Action (March 15, 2006), page 12, paragraph 6 (emphasis added). Applicants submit that even if someone were motivated to “avoid manual back-up of registry keys,” it does not follow that they would be motivated to store a path to an original document as a registry key associated with a local copy. In other words, the Examiner’s stated motivation does not lead someone of ordinary skill in the art to the present invention. At best, the stated motivation may lead someone to back up registry keys at a remote computer to synchronize data. See Final Office Action (March 15, 2006), page 11, paragraph 6. Nevertheless, this is not the same as, storing a path of an original document as a registry key of a local copy of the original document.

Accordingly, the Examiner has not established a prima facie case of obviousness with respect to claims 13 and 21, because she has failed to provide adequate motivation for combining Pham with Brown.

Claims 6-7, 9, 10, and 17-18 depend from one of claims 1, 5 and 13, and thus are allowable for at least the same reasons as claims 1, 5, and 13.

For at least these reasons, Applicants respectfully request reconsideration of the rejection of all of the pending claims 1-14 and 16-28 in view of Brown, Moody, Pham, and Thorne as each of these claims are believed to recite the present invention in a manner distinguishable over the above references individually and in any combination.

Conclusion

This Amendment fully responds to the Final Office Action mailed on March 15, 2006. Still, that Office Action may contain arguments and rejections and that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

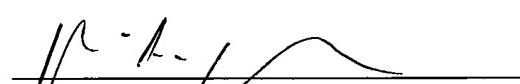
It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

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Respectfully submitted,

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